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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,353	11/13/2001	Steven G. Corveleyn	55728US002	1999

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EXAMINER

RAJGURU, UMAKANT K

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ART UNIT            PAPER NUMBER

1711

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-5

## Office Action Summary

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

**— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- Responsive to communication(s) filed on \_\_\_\_\_
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

### Disposition of Claims

<input checked="" type="checkbox"/> Claim(s) <u>1-26</u>	is/are pending in the application.
Of the above claim(s) <u>1-15 and 23-26</u>	is/are withdrawn from consideration.
<input type="checkbox"/> Claim(s) <u>16-20</u>	is/are allowed.
<input checked="" type="checkbox"/> Claim(s) <u>21 &amp; 22</u>	is/are rejected.
<input type="checkbox"/> Claim(s) _____	is/are objected to.
<input type="checkbox"/> Claim(s) _____	are subject to restriction or election requirement

### Application Papers

- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
  - All  Some\*  None of the:
    - Certified copies of the priority documents have been received.
    - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - Copies of the certified copies of the priority documents have been received
      - in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

<input checked="" type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). <u>2</u>	<input type="checkbox"/> Interview Summary, PTO-413
<input checked="" type="checkbox"/> Notice of Reference(s) Cited, PTO-892	<input type="checkbox"/> Notice of Informal Patent Application, PTO-152
<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948	<input type="checkbox"/> Other _____

## Office Action Summary

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to use of a mineral oil, classified in class none, subclass none.
- II. Claims 8-15, drawn to a method, classified in class 264, subclass 139.
- III. Claims 16-22, drawn to a composition, classified in class 524, subclass 275.
- IV. Claims 23-26, drawn to a method, classified in class 524, subclass 276.

The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the use of mineral oil can be made in a method of making a moldable composition based a thermosetting polymer.

Inventions I and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a starting material for a lubricant and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or

identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case mineral oil can be used in a method of making a composition based on polymer/s other than fluoroelastomers.

Inventions III and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method as claimed can be practiced with another materially different product such as polyethylene, polystyrene.

Inventions IV and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

process of using that product (MPEP § 806.05(h)). In the instant case the method as claimed can be used to make a composition containing polyurethane, plasticizer and fillers.

Inventions IV and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make a materially different product such as a blend of phenolic resin and saw dust.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Attorney Dean M. Harts on October 15, 2002 a provisional election was made with traverse to prosecute the invention of III, claims 16-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-15 and 23-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Claims 21 and 22 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple

dependent claim. See MPEP § 608.01(n). Accordingly, the claims 21 and 22 have not been further treated on the merits.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawes et al (USP 4485062).

Dawes discloses a process for extruding polymers (abstract) fluoroelastomers are one class of such polymers (col. 4, lines 19-21). Carbon black and some inorganic materials can be added to polymers (col. 4, lines 26-35). Mineral oils can be incorporated into the polymers (col. 5, lines 15, 28-32).

Dawes does not mention anything about wax content of mineral oil. It is reasonable to assume that the wax content is less than 2 parts per 100 parts by wt. Of composition (as claimed) since the oil of Dawes is a mineral oil used at a low amount of 0.03% by wt (col. 5, line 2).

It would have been obvious to from teachings of Dawes to arrive at instant invention.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dawes et al (USP 4485062).

Disclosure of Dawes, set forth earlier, <sup>shows</sup> ~~pores~~ that claims 16-20 lack novelty.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U.K. Rajguru whose telephone number is 703-308-3224. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700

U. K. Rajguru/mn  
March 4, 2003